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In re Application of	:	
EBERL	:	
Serial No.: 10/551,443	:	DECISION ON
PCT App. No.: PCT/EP01/11634	:	
Int'l Filing Date: 08 October 2001	:	PETITION
Priority Date: 07 October 2000	:	
Attorney Docket No.: 101795.56306US	:	UNDER 37 CFR 1.47(a)
For: DEVICE AND METHOD FOR DETER-	:	
MINING THE ORIENTATION OF AN EYE	:	

This decision is in response to applicant's petition under 37 CFR 1.47(a) and filed 06 April 2009 in the above-captioned application in the United States Patent and Trademark Office (USPTO). This is also responsive to applicant's request for status under 37 CFR 1.42.

BACKGROUND

On 07 August 2008, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), was required along with an English translation of the international application and the surcharge and processing fees for filing these documents after the thirty month period.

On 07 November 2008, applicant filed, inter alia, two executed declarations and a letter from German attorney Matthias Mayer.

On 05 February 2009, a decision was mailed indicating that the declarations were unacceptable because they were not in compliance with 37 CFR 1.497(a) and (b). It was suggested that applicant file a petition under 37 CFR 1.47(a).

On 11 February 2009, a Notification of Defective Response was mailed indicating that oath or declaration does not give evidence that inventor Mayer refuses to sign the oath. On 20 February 2009, a communication issued vacating the Notification of Defective Response and allowing applicant two months within which to respond to the decision or by 5 April 2009, with extensions of time available.

On 06 April 2009, applicant filed a petition pursuant to 37 CFR 1.47(a) to accept the application without the signature of Matthias Mayer, as the legal representative of deceased

inventor Roland H. C. Eberl.

DISCUSSION

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, *if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative.*

The declaration does not indicate the citizenship, residency and mailing address of the legal representative and thus, the declaration is defective under 37 CFR 1.497(b)(2). The declaration must state the relationship and state the country of citizenship, former residency and mailing address for *both* the deceased inventor and the legal representative, to meet the requirements for compliance with 37 CFR 1.497(a) and (b).

What is required is a declaration, which identifies all inventors including the deceased inventor Roland Eberl and the legal representative for deceased inventor. The declaration must provide the citizenship, residency and mailing address for all inventors, including the legal representative and deceased inventor's citizenship, former residency and mailing address on the declaration.

Petition under 37 CFR 1.47(a)

Since the legal representative for the deceased inventor is required to execute the declaration and appears unwilling to do so, a petition under 37 CFR 1.47(a) is required. A petition under 37 CFR § 1.47(a) must be accompanied by (1) the fee under 37 CFR § 1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite \$200 petition fee, satisfying Item (1). A statement of non-signing legal representative's last known address was provided, satisfying Item (3).

With respect to Item (2), Petitioner employs the declaration of David Dickerson, who describes his contact with Matthias Mayer, the legal representative of deceased inventor Roland Eberl. Mr. Dickerson indicates that in October 2008, he contacted Mr. Mayer by telephone regarding this patent application.

On March 13 and March 30, 2009, Mr. Dickerson sent correspondence to Mr. Mayer

about the USPTO's finding that there was insufficient evidence to conclude that Mr. Mayer refused to sign the declaration as the legal representative of the deceased inventor. Mr. Mayer responded with a letter dated March 31, 2009. An English translation of Mr. Mayer's letter was attached to the petition. Mr. Mayer's letter indicates from the assignment documents, it appeared that "the deceased had assigned all rights from the subject patent while still alive and had received compensation. For this reason, I thus also did not see myself in a position to provide, in this respect a declaration....in the meantime, the curatorship has been closed again." Petitioner also relies on Mr. Mayer's letter of November 3, 2008. With the evidence presented, it can be concluded that Mr. Mayer refuses to sign the declaration as the legal representative on behalf of the deceased inventor. Item (2) is satisfied.

As for Item (4), a declaration executed by the joint inventor on his behalf and on behalf of the non-signing inventor was provided but is not acceptable as explained above.

In sum, Petitioner has satisfied Items (1), (2) and (3). As set forth above, Petitioner has not satisfied Item (4). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

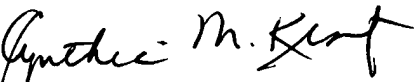
CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE**. The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Applicant is required to correct the above-noted defects including the furnishing of a oath/declaration in compliance with 37 CFR 1.42, 1.47(a) and 1.497(a) and (b).

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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